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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 10, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tomima L. Edmark

Serial No. 75/059,147

Anna R. Conyers of Baker & Botts, L.L.P. for Tomima L.
Edmark

Jeri J. Fickes, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney)

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Tomima L. Edmark has applied to register, pursuant to
the provisions of Section 2(f), the following configuration
as a trademark for a "hair loop tool used for hair
styling."¹ The application includes the following
description: "The mark consists of the configuration of a

hair styling tool composed of a plastic loop attached to a straight handle."

A final refusal of registration issued pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that the proposed mark is de jure functional.²

Applicant filed the instant appeal. The case has been fully briefed, and both applicant and the Examining Attorney were present at an oral hearing before the Board.

¹ Application Serial No. 75/059,147, filed February 16, 1996, asserting first use in May 1992 and first use in commerce in June 1992.

² On October 30, 1998, the Trademark Act was amended to list functionality as a specific ground for refusal. See Section 2(e)(5), "comprises any matter that, as a whole, is functional." Although the amendment does not affect our analysis herein, because the statute was amended after the application was examined and the appeal was briefed, we have referred to the statutory ground for refusal as indicated by the Examining Attorney.

The Examining Attorney had originally also refused registration on the ground that the proposed mark was not inherently distinctive. When the Examining Attorney accepted applicant's Section 2(f) claim, this refusal was withdrawn. Accordingly, the issue of the distinctiveness of applicant's mark is not before us.

Applicant seeks registration for the configuration of a hair styling tool. The hair tool itself is used, essentially, to invert a ponytail, and thereby create different hair styles. According to applicant's literature and instructional videos, the tool is drawn part way through the ponytail, the hair of the ponytail is then passed through the loop of the tool, and the tool is then pulled through the hair to invert the tail of hair. The configuration, as shown by the drawing and the specimens, consists of a single piece of material (which, in fact, is plastic), with a teardrop-shaped loop at one end of a flat straight handle, and a pointed tip at the other end of the handle. The loop portion of the tool is slightly smaller in length as compared with the handle.

A configuration is considered de jure functional, and therefore not registrable, if it is so utilitarian as to constitute a superior design which others in the field need to be able to copy in order to compete effectively. **In re Edward Ski Products Inc.**, 49 USPQ2d 2001 (TTAB 1999); see also, **In re Teledyne Industries, Inc.**, 696 F.2d 968, 217 USPQ 9 (Fed. Cir. 1982); **In re Morton-Norwich, Inc.**, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). Evidentiary factors which are useful in demonstrating such de jure

functionality include the existence of a utility patent; whether the applicant touts the utilitarian advantages of the design through advertising; the availability of alternative designs; and whether the design results from a comparatively simple or cheap method of manufacturing the article. **In re Morton-Norwich Products, Inc.**, supra.

In this case, there is no evidence that applicant touts the utilitarian advantages of the design. In this connection, we have given no weight to the Examining Attorney's speculation that advertising touting the utilitarian advantages of the design might exist.

There is also no evidence that applicant's design results from a comparatively simple or cheap method of manufacturing the article. We agree with the Examining Attorney, however, that applicant is in the best position to provide this information, and it would have been helpful if applicant had provided information about the method of manufacture of its own product and, if possible, information about how such tools are generally manufactured, rather than simply stating that it has no information about other companies' manufacturing methods and costs. See **In re EBSCO Industries Inc.**, 41 USPQ2d 1913, 1915 (TTAB 1997), noting that applicant's director had submitted an affidavit stating that applicant's lure is

made by injection molding of plastic, and there is no appreciable cost difference in creating a mold for one lure shape as opposed to another.

Although there is no evidence that applicant touts the utility of its configuration in its advertising materials, or that the configuration results from a cheaper method of manufacture, the record does include a utility patent and information with respect to alternative configurations.

Applicant owns a utility patent for a hair styling tool. The illustration of the tool, which forms an embodiment of the invention, is very similar to the configuration sought to be registered. The illustration shown in the patent and the mark shown in the trademark application are depicted below.

The patent indicates the utilitarian advantages of many of the features of the configuration which is the subject of the trademark application. In particular, the

patent describes a relatively elongate and inflexible probe having a point at one end of the probe and a flexible loop at the other. The patent indicates the advantages of these features. For example, the patent states that "the point allows the probe to be inserted to glide with little friction through the hair, and without pulling excessively on the hair itself." As for the flexible loop, "the flexibility of the loop allows it to flatten or deform as it is pulled through the hair, yet rebound to its natural ring shape." "The deformation occurs in the flexing of the material forming the loop, which allows the opening through the loop to conform to the hair."

We note that the patent shows the tool with a cylindrical probe, and with the end of the probe extending with a point somewhat into the loop, while the probe in the mark sought to be registered is flat and while loop end of the probe tapers, it ends at the beginning of the loop. However, we do not regard these differences as indicating that the configuration as a whole does not have a superior utilitarian design. In fact, it appears that the configuration shown in the trademark application is superior to that shown in the patent illustration, in that it does not have a pointed end extending into the loop, thus avoiding the possibility of such an end catching in or

pulling excessively on the hair tail as it is pulled through the loop. Further, because there is no pointed end extending into the loop, the flat probe provides an advantage over the cylindrical probe referred to in the patent. If a cylindrical probe were to end at the loop, instead of extending into the loop, it would appear that the junction of the cylindrical probe with the loop would narrow such that this would be a weak point and could snap during use. It would also appear that to thicken the junction to avoid this weakness would require greater bulk/material, which in turn could increase manufacturing costs. Thus, the use of a flat probe appears to provide design advantages over a cylindrical probe.

Applicant has argued that her patent includes various embodiments of the elements claimed in the patent, e.g., "the triangular point [at the tip of the probe] is only one of many different types of equivalent points," brief, p. 11; the "cylindrical" probe would encompass a probe which is tubular, triangular, spiral or other shape. This argument is not persuasive. To the extent that applicant asserts that the configuration does not represent a superior design, but that alternative versions are covered by the patent, as we pointed out above, the illustration in applicant's utility patent contains most of the elements of

the applied-for configuration as the preferred embodiment of the claimed invention. Further, even if variations on that preferred embodiment are encompassed by the patent, there cannot be substantial variations from the illustration. See **In re Edward Ski Products Inc.**, supra.

The other Morton-Norwich factor on which evidence has been submitted is the existence of other hair styling tools. There is some confusion about the number of alternative designs which are of record. Applicant asserts that, allowing for duplicates, there are at least eleven alternative designs which have been submitted, while the Examining Attorney states that there are only nine. After carefully reviewing the photographs of the various hair styling tools, we agree with the Examining Attorney that there are nine shapes which have been submitted.

Moreover, many of these shapes are mere variations of each other. For example, three of the tools consist of an open strand of plastic which must be hooked or held together to form a loop through which the hair can be pulled. These three tools are clearly not equivalent alternatives to applicant's tool; they would be harder to use because, as the Examining Attorney points out, they would have to be manipulated into closed shapes.

Similarly, two of the other tools are essentially the same elongated oval shape, with the only real difference between them being that one probe has a pointed tip and the other a blunt end. Three other tools have more complicated loop shapes which appear to be more likely to catch the tail hair, or at least be more difficult to maneuver. In fact, there is only one tool which has the flexible loop which is touted as an advantage in applicant's patent because it can "conform to the hair" and "deform under the influence of external forces" as it is pulled through the hair tail. That tool has a blunt, rather than pointed, end, so it obviously does not have the utilitarian advantage of applicant's tool since the pointed tip, according to applicant's patent, allows the probe to be inserted in the hair tail without pulling excessively on the hair itself.

Thus, although there may be alternative shapes for tools used to invert a tail of hair to create pleasing hair styles, based on the present record we find that applicant's configuration is the best, or at least one of a few superior designs. See **In re Lincoln Diagnostics Inc.**, 30 USPQ2d 1817, 1824-25 (TTAB 1994) and cases cited therein.

Ser No. 75/059,147

In view of the utilitarian advantages of applicant's configuration, as shown by her patent, and the lack of equivalent alternative designs, we find that applicant's configuration is de jure functional.

Decision: The refusal of registration is affirmed.

R. L. Simms

R. F. Cissel

E. J. Seeherman
Administrative Trademark Judges
Trademark Trial and Appeal Board